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DIRECTOR OFFICE  
TECHNOLOGY CENTER 2600

In re Application of:  
James Nicholas Seymour  
Application Serial No.: 08/987,995  
Filed: December 10, 1997  
For: **PORTABLE ELECTRONIC APPARATUS**

DECISION ON PETITION

This is a decision on the petitions, pursuant to 37 C.F.R. §1.181 filed May 12, 2004 and May 20, 2004 which requests a review of the validity of the Examiner's action in reopening prosecution following the Decision of the Board of Patent Appeals and Interferences of March 31, 2003.

On March 31, 2003, the Board of Patent Appeals and Interferences rendered a decision, reversing the Examiner with respect to the rejection of all pending claims (paper No. 18). On November 20, 2003, the Examiner mailed out a new non-final Office action (paper No. 19), thus reopening prosecution. An earlier petition regarding the appropriateness of the Office action given the apparent lack of authority for reopening prosecution, was filed on January 23, 2004. A petition decision was mailed on April 20, 2004 which granted the earlier petition and vacated the original Office action given the apparent lack of authority to reopen.

A review of the application reveals that a new non-final Office action was mailed on May 4, 2004.

37 CFR § 1.198 Reopening after decision, states:

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 1.196 without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown. [49 FR 48416, Dec. 12, 1984, effective date Feb. 11, 1985; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003] [emphasis added]

MPEP §1214.04 Examiner Reversed, states in part:...

If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. See MPEP § 1002.02(c) and MPEP § 1214.07. The TC Director's approval is placed on the action reopening prosecution. [emphasis added]

A review of the new non-final Office action mailed May 4, 2004 reveals that the action was in fact signed by the TC Director and thus sufficient cause was demonstrated and reopening of prosecution approved by the appropriate authority.

Petitioner further commented that "...the Board makes it quite clear that Saji cannot be used to satisfy the burden of showing obviousness of Applicant's invention for purposes of 35 U.S.C. §103(a)".

In response to petitioner's comments, the Board's decision was rendered with respect to the combination of Saji in view of French. Saji taught a cordless telephone and French a laptop or notebook computer that deals with the problem of theft and that there was no suggestion found for providing an anti-theft mechanism for Saji's cordless telephone. This does not suggest that the Saji reference is otherwise an appropriate reference, particularly if combined with a relevant secondary teaching.

Accordingly, given that the Office action mailed May 4, 2004 did in fact contain the appropriate authorization, i.e., signed by the Technology Center Director, then petitioner's request to withdraw the Office action and purge from the file, **Denied**.



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Andy Faile, Director  
Technology Center 2600  
Communications